REMARKS

Applicant has carefully reviewed the Office Action mailed May 13, 2010 (hereinafter "Office Action"), and respectfully requests reconsideration of the subject application, particularly in view of the above amendments and the following remarks.

Status of the Claims

Claims 61-64, 66-70, and 72-92 were previously pending. Claims 1-60, 65, 71, and 93-108 were previously cancelled. No claims are added or cancelled herein. Accordingly, claims 61-64, 66-70, and 72-92 remain pending.

Claim Objections

Claim 78 was objected to because of an informality, which has been corrected above, and Applicant therefore respectfully requests that the objection be withdrawn.

Rejection Under 35 U.S.C. § 112, First Paragraph

Claims 61, 78, and 89 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In particular, the Patent Office asserts that the limitation "*selecting, by the processing device, a matching user profile from the plurality of user profiles*," as recited in claim 61, and as substantially recited in claims 78 and 89, was not described in the Specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. Applicant respectfully traverses.

Applicant notes that substantially the same limitation was rejected on the same basis in the Office Action mailed on February 2, 2009. In the response filed on May 4, 2009, Applicant directed the Patent Office's attention to paragraphs [0090] and [0091] of the subject application. Such paragraphs state:

> [0090] The user's profile is communicated to a server (such as server 11 of FIGS. 1 and 2), as shown in block 32. At the server, the user's profile is compared to the profiles of other users as shown in block 33. An attempt is made to match the user's profile to the profile of one or more other users, so as to identify other users having similar tastes and interests.
>
> [0091] The playlists of one or more other users, whose profiles best match the user's profile, are communicated to the user's device as shown in block

> 34. Any desired method or algorithm for such matching may be used. For example, each time the responses to two questionnaires match, a number could be added to a score for that particular matching process. The matching processes that result in the highest scores could be considered close enough matches to cause a playlist to be sent. Alternatively, any matching process that result in a score that exceeds a predetermined threshold value may be considered a match. (Emphasis added.)

Such paragraphs indicate that a user's profile is communicated to a server, where the profile is compared to the profiles of other users, and upon a match, the playlists of one or more other users are communicated to the user's device. Applicant submits that paragraphs [0090] and [0091] clearly convey that the inventor had possession of the claimed invention as of the filing date of the present application. Applicant also notes that the rejection was not raised again in the Final Office Action mailed August 19, 2009 or the Advisory Action mailed November 3, 2009, leading Applicant to reasonably conclude that the rejection had been withdrawn.

Applicant further notes that when a disclosure describes a claimed invention in a manner that permits one skilled in the art to reasonably conclude that the inventor possessed the claimed invention, the written description requirement is satisfied (MPEP § 2163). This may be shown in any number of ways, and an Applicant need not describe every claim feature exactly because there is no *in haec verba* requirement (*Ibid.*). Rather, to satisfy the written description requirement, all that is required is "reasonable clarity" (MPEP § 2163.02). Also, an adequate description may be made in any manner through express, implicit, or even inherent disclosures in the application, including words, structures, figures, diagrams, and/or formulae (MPEP §§ 2163(I), 2163.02).

Applicant submits that one of ordinary skill in the art would reasonably conclude that Applicant's disclosure adequately described the claimed invention at the time of filing at least because the feature "*selecting, by the processing device, a matching user profile from the plurality of user profiles*," is practically a verbatim recitation of the Specification, which discloses that "[a]n attempt is made to match the user's profile to the profile of one or more other users." In view of the foregoing, Applicant respectfully submits that ordinarily skilled artisans would reasonably conclude that Applicant possessed the claimed limitation on the basis of at least the aforementioned descriptions, which, again, are almost verbatim recitations of the limitation at issue. Thus, the present application clearly describes the claimed invention, and Applicant thus respectfully requests that the rejection be permanently withdrawn. In the event

the Patent Office maintains this rejection, Applicant respectfully requests that the Patent Office explain how the aforementioned portions of the present application fail to communicate to a skilled artisan that Applicant possessed the claimed invention.

Rejection Under 35 U.S.C. § 102(b) – Ward

Claims 61-64, 66, 68-70, and 75-77 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,526,411 B1 to Ward (hereinafter "Ward"). Applicant respectfully traverses.

Applicant's claim 61 recites "*selecting, by the processing device, a matching user profile from the plurality of user profiles.*" Ward fails to teach or suggest selecting a matching user profile from a plurality of user profiles, and thus Ward cannot anticipate Applicant's claimed invention. In particular, Ward discloses that, in one embodiment, a seed profile may be compared to other profiles which are ranked, and that the most similar profiles are "clustered" with the seed profile (Ward, elements 540, 541, and 542 of Fig. 8, and column 9, lines 8-23). The Patent Office asserts that "[i]t will be readily recognized that the most similar profile(s) must be identified or selected from similar profiles for being clustered with the selected seed user profile" (Office Action, pages 4-5). However, nowhere does Ward disclose selecting "a matching user profile" from the compared user profiles, as required by Applicant's claimed invention. One reason for this may be that the goal of the comparison in Ward is different from Applicant's claimed invention. The purpose for the comparison in Ward is to create a "dynamic playlist" which "has a high correlation with the user's preference" (Ward, Abstract). A "dynamic playlist" is generated by determining a "seed meta-category" and querying content providers to obtain content pieces that fit the seed meta-category. The content pieces may be further ranked or culled (*Id.* at column 6, lines 55-67). In the embodiment relating to Figure 8, it appears to Applicant that the purpose of clustering user profiles is to determine popular "elements," which in turn appears to be a shorthand reference to "meta elements," which are used to query content providers (*Id.* at column 9, lines 15-16 and column 4, lines 59-63). Thus, the clustering of user profiles is carried out to determine meta elements which may be used to find content items. Therefore, there is no reason in Ward to select a matching user profile from a plurality of user profiles.

In contrast to determining meta elements for use in finding content items, Applicant's invention is directed to "*selecting a playlist of a matching user associated with the matching user profile.*" Ward fails to teach or suggest this feature for the reasons discussed above. Ward is not attempting to locate an existing playlist; Ward is attempting to create a "dynamic playlist" based on meta elements.

Because at a minimum Ward fails to disclose either selecting a matching user profile from a plurality of user profiles, or selecting a playlist of a matching user associated with the matching user profile, Applicant submits that Ward cannot anticipate Applicant's claimed invention. Therefore, Applicant believes that claim 61 is patentable over Ward.

Claims 62-64, 66, 68-70, and 75-77 depend directly or indirectly from claim 61, and are therefore allowable as depending from an allowable independent claim.

Rejection Under 35 U.S.C. § 102(b) – Chislenko

Claims 89, 90, and 92 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,041,311 to Chislenko et al. (hereinafter "Chislenko"). Applicant respectfully traverses.

Chislenko discloses a system wherein items in a category, or "domain," may be recommended to a user of the system based on similarities between the rating of such items by the respective user and the rating of such items by a group of "neighboring users" of the system (Chislenko, column 3, lines 6-14; column 8, lines 1-18; and column 9, lines 39-48). Chislenko discloses that the group of neighboring users of the system may be determined, at least in part, by "comparing that user's profile with the profile of every other user of the system" (*Id.* at column 5, lines 51-55). Applicant notes, however, that the profiles in Chislenko are compared not to select a user from which the system can obtain a playlist, but to determine which other users rate items similarly, i.e., to determine the group of "neighboring users" (*Id.* at column 8, lines 1-18). Applicant's claimed invention, in contrast, compares profiles to determine a "matching user profile" and to select a playlist of the matching user. For example, claim 89 recites "*select a matching user profile from the plurality of user profiles, the matching user profile associated with a second user from the plurality of users.*" Chislenko fails to teach or suggest this feature. The Patent Office asserts that this limitation is disclosed at column 5, lines 29-33 of Chislenko (Office Action, page 8), wherein Chislenko discloses that similarity factors

for each user are calculated with respect to to all other users. Applicant notes that the referenced portion fails to teach or suggest that a "matching user profile" is selected. This is because Chislenko desires to determine which items have been highly rated by a group of "neighboring users," not to locate a particular matching user who may have a playlist of interest to a target user (see column 10, lines 1-6 of Chislenko).

Chislenko also fails to teach or suggest "*effect selection of a playlist of the second user from the plurality of playlists for delivery to the media player device,*" as recited in claim 89. The Patent Office refers to column 10, lines 3-5 of Chislenko, wherein items highly rated by a user's neighbors is disclosed (Office Action, page 8). However, Applicant's claimed invention does not relate to items highly rated by a group of neighbors; rather, Applicant's claim 89 specifically requires "*selection of a playlist of the second user from the plurality of playlists.*" Nowhere does the cited portion of Chislenko, or indeed any portion of Chislenko, teach or suggest selection of a playlist of a second user.

Applicant's claim 89 further recites "*communicate the playlist of the second user to the media player device.*" The Patent Office asserts that Chislenko discloses this feature at column 19, lines 41-42 and column 21, line 12, wherein Chislenko discloses that the system can provide recommendations (Office Action, page 9). Even assuming, *arguendo*, that recommendations are equivalent to a playlist, Applicant notes that the recommendations are based on the ratings of the neighboring users (see Chislenko, column 10, lines 3-6). Nowhere does Chislenko suggest that the recommendations are a playlist of a matching user associated with a matching user profile, as recited in Applicant's claim 89.

For at least these reasons, Applicant submits that claim 89 is allowable over Chislenko. Claims 90 and 92 depend from claim 89, and are therefore allowable as depending from an allowable independent claim.

Rejection Under 35 U.S.C. § 103(a) – Ward and Elliott

Claim 72 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Ward in view of U.S. Patent Application Publication No. 2005/0165888 A1 to Elliott (hereinafter "Elliott"). Applicant respectfully traverses.

Claim 72 depends from claim 61, and is therefore allowable as depending from an allowable independent claim.

Rejection Under 35 U.S.C. § 103(a) – Ward and Mercer

Claim 73 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Ward in view of U.S. Patent Application Publication No. 2004/0078382 A1 to Mercer et al. (hereinafter "Mercer"). Applicant respectfully traverses.

Claim 73 depends from claim 61, and is therefore allowable as depending from an allowable independent claim.

Rejection Under 35 U.S.C. § 103(a) – Ward and Smith

Claim 74 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Ward in view of U.S. Patent Application Publication No. 2004/0133914 A1 to Smith et al. (hereinafter "Smith"). Applicant respectfully traverses.

Applicant's claim 74 recites "*filtering the playlist to remove at least one item that is not compatible with a location of the media player device.*" The Patent Office asserts that paragraph 0069 of Smith discloses this feature (Office Action, page 11). Applicant respectfully disagrees. Paragraph 0069 of Smith discloses that advertisements may include metadata that includes a geographic location. The metadata may be used by a predictive downloader to download the advertisement to a computer.

Applicant submits that the use of location metadata associated with an advertisement that is downloaded fails to teach or suggest removing an item that is not compatible with a location of the media player device. Thus, Applicant submits that claim 74 is allowable over the cited reference.

Rejection Under 35 U.S.C. § 103(a) – Ward and Chislenko

Claims 67, 78-81, and 85-88 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ward in view of Chislenko. Applicant respectfully traverses.

Claim 78 recites "*select a matching user profile from the plurality of user profiles.*" The Patent Office asserts that Ward discloses this feature (Office Action, page 12). For the reasons discussed above with respect to the substantially similar limitation of claim 61, which for purposes of brevity will not be repeated herein, Applicant submits that Ward fails to teach or

suggest selecting a matching user profile from a plurality of user profiles, and thus Ward cannot anticipate Applicant's claimed invention.

Claim 78 further recites "*request delivery of a playlist of a matching user associated with the matching user profile from a server storing the playlist to the media player device.*" The Patent Office concedes that Ward fails to teach or suggest this feature, but asserts that Chislenko discloses this feature (Office Action, page 13). For the reasons discussed above with respect to claim 89, which for purposes of brevity will not be repeated herein, Applicant disagrees that Chislenko teaches or suggests either selection "*of a playlist of a matching user associated with the matching user profile,*" or delivery thereof. As discussed above, Chislenko discloses that items may be recommended to a user of a system based on similarities between the rating of such items by the respective user and the rating of such items by a group of "neighboring users" of the system. Chislenko fails to teach or suggest delivery of a playlist of a matching user, in part because Chislenko fails to teach or suggest selecting a playlist of a matching user.

Claim 67 depends from claim 61, and is therefore allowable as depending from an allowable independent claim. Claims 79-81 and 85-88 depend from claim 78, and are therefore allowable as depending from an allowable independent claim.

Rejection Under 35 U.S.C. § 103(a) – Ward, Chislenko, and Elliott

Claim 82 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Ward in view of Chislenko and Elliott. Applicant respectfully traverses. Claim 82 depends from claim 78, and is therefore allowable as depending from an allowable independent claim.

Rejection Under 35 U.S.C. § 103(a) – Ward, Chislenko, and Mercer

Claim 83 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Ward in view of Chislenko and Mercer. Applicant respectfully traverses. Claim 83 depends from claim 78, and is therefore allowable as depending from an allowable independent claim.

Rejection Under 35 U.S.C. § 103(a) – Ward, Chislenko, and Smith

Claim 84 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Ward in view of Chislenko and Smith. Applicant respectfully traverses. Claim 84 depends from claim 78, and is therefore allowable as depending from an allowable independent claim.

Rejection Under 35 U.S.C. § 103(a) – Chislenko and Elliott

Claim 91 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Chislenko in view of Elliott. Applicant respectfully traverses. Claim 91 depends from claim 89, and is therefore allowable as depending from an allowable independent claim.

Conclusion

The present application is now in condition for allowance and such action is respectfully requested. The Examiner is encouraged to contact Applicant's representative regarding any remaining issues in an effort to expedite allowance and issuance of the present application.

Respectfully submitted,

WITHROW & TERRANOVA, P.L.L.C.

By: 

Eric P. Jensen
Registration No. 37,647
100 Regency Forest Drive, Suite 160
Cary, NC 27518
Telephone: (919) 238-2300

Date: August 13, 2010
Attorney Docket: 1116-065